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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 10/630,497 | 07/29/2003 | Barry P. Lubart | GB920030044US1(1397-2U) | 9688 |
| 68786 7590 05/28/2008 CHRISTOPHER & WEISBERG, P.A. 200 EAST LAS OLAS BOULEVARD SUITE 2040 FORT LAUDERDALE, FL 33301 | | | | |
| EXAMINER | | | | |
| VETTER, DANIEL | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3628 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 05/28/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/630,497

Applicant(s)

LUBART, BARRY P.

Examiner

DANIEL P. VETTER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40,41 and 43-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40,41 and 43-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI-108)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. Claims 40-41 were previously pending in this application. Claims 40-41 were amended, and new claims 43-50 were added in the reply filed February 21, 2008. Claims 40-41 and 43-50 are currently pending in this application.

Response to Arguments

2. Applicant's amendments overcome the objection made to claim 41 and it is withdrawn.

3. In response to applicant's arguments with regard to the rejections made under § 102(b), and to clarify the application of the Lorch reference to the claimed invention, examiner notes that the "proxy address" disclosed in Lorch supplies the teaching of the claimed "pseudo name" which is applied to the mail piece in place of a physical address. The claimed "user profile" (including the franking, naming, and dynamic mail function profiles that together comprise the user profile) is taught by Lorch as information and instructions stored in a database and associated with the proxy address. They serve the same purpose and contain the same information as the franking, naming, and dynamic mail function profiles, (i.e., payment, physical address correlation, and special handling). The associated data and instructions are not explicitly referred to as distinct "profiles", however identity of terminology in a prior art reference is not a requirement for anticipation under § 102. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). The profile elements are still arranged as recited in the base claims (i.e., associated with the pseudo name), and accordingly the rejections are maintained.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 43-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 43-46 are directed to a "system" and therefore not considered processes for the purposes of § 101. However, these claims recite actions or steps as part of the system (e.g., "pseudo name is placed on the mail object", "recipient is billed for the one or more mail services", etc.). A single claim that claims both an apparatus and the method steps of using the apparatus is indefinite. *IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005). These claims do not properly apprise the public as to what would constitute infringement (i.e., creation of the claimed system or the act of using it) and accordingly are rejected as vague and indefinite under § 112, second paragraph.

7. Claims 47 and 49 recite "instructions which cause the computer to place the pseudo name on the mail object". It is unclear in light of the Specification and the generally recognized meaning of the terminology how a "computer" and program instructions alone, without any other associated hardware components, is used to place a pseudo name on a physical object. It also appears in claims 47 and 49 that the same computer and the same program which previously determined the displayed pseudo name on the mail object in the base claims, places that same pseudo name on the mail object in the dependent claims, which is confusing. Claims 48 and 50 inherit these deficiencies through dependency and, as such, are rejected for the same reasons.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claims 40-41, 43-44, and 47-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Lorch, et al., Intl. Pat. Pub. No. WO 02/51051 (Reference 1 of the IDS submitted 5/23/2005).

10. As per claim 40, Lorch teaches a system for routing a mail object in a postal service to a designated person, the system comprising: means for registering a pseudo name (pg 11, line 18) and providing instructions for one or more mail services in a user profile associated with the pseudo name (pg 11, lines 8-10, 19-21), the user profile having: a franking profile including a method of payment for a mail object (pg 23, lines 8-11); a naming profile including name and address information for an associated user (pg 19, lines 15-17); a dynamic mail function profile including a listing of the one or more mail services associated with the pseudo name (pg 22, lines 9-12); and a designated time frame for which the user profile is active (pg 20, line 8); means for determining a registered pseudo name to locate the user profile associated with the registered pseudo name (pg 12, lines 4-6); and means for executing the instructions for the one or more mail services during the designated active time frame in the user profile (pg 12, lines 7-8, 14-15).

11. As per claim 41, Lorch teaches a computer readable storage medium having a computer readable program for a mail service which when executed on a computer causes the computer to: store a pseudo name to be displayed on a mail object (pg 10, lines 2-3); store a user profile associated with the pseudo name (pg 28, lines 12-14), the user profile including: a franking profile including a method of payment for a mail object (pg 23, lines 8-11); a naming profile including name and address information for an associated user (pg 19, lines 15-17); a dynamic mail function profile including instructions for one or more mail services associated with the pseudo name (pg 22, lines 9-12); determine the registered pseudo name displayed on the mail object to locate the user profile (pg 10, lines 12-13); and store a designated time frame for which the user profile is active (pg 22, lines 14-16).

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12. As per claim 43, Lorch teaches the system of claim 40 as described above.

Lorch further teaches the pseudo name is placed on the mail object to identify a recipient of the mail object (pg 11, lines 12-14).

13. As per claim 44, Lorch teaches the system of claim 40 as described above.

Lorch further teaches the recipient is billed for the one or more mail services associated with the pseudo name according to the method of payment for the mail object included in the franking profile (pg 37, lines 11-13).

14. As per claim 47, Lorch teaches the medium of claim 41 as described above.

Lorch further teaches instructions which cause the computer to place the pseudo name on the mail object to identify a recipient of the mail object (pg 34, lines 9-12).

15. As per claim 48, Lorch teaches the medium of claim 47 as described above.

Lorch further teaches instructions which cause the computer to bill the recipient for the one or more mail services associated with the pseudo name according to the method of payment for the mail object included in the franking profile (pg 37, lines 11-13).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 45 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorch, et al.

18. As per claim 45, Lorch teaches the system of claim 40 as described above.

Lorch further teaches the pseudo name is placed on the mail object to identify a recipient of the mail object (pg 11, lines 12-14); and also teaches that a sender name and physical address is placed on the mail object to identify a sender of the mail object (Fig. 1); however does not explicitly teach that the pseudo name is placed on the mail object to identify a sender of the mail object rather than just the recipient. Thus, the

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difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself—that is, in the substitution of the physical sender address with a pseudo address (rather than just the recipient address). Both addresses share similar characteristics and functions. It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate a sender pseudo name because it is merely the simple substitution of one known element for another that could be implemented through routine engineering to produce only predictable results. Moreover, the usefulness of the pseudo name as suggested by Lorch is applicable for sender as well as recipient addresses. The advantage of the pseudo name is that it allows physical address delivery without the other party knowing the physical address (pg 16, lines 12-14). This is also applicable to return mail, as senders may wish to keep their physical address unknown for the same reasons as recipients, but may still desire return correspondence from the initial recipient. Additionally, this allows businesses to use an easy-to-remember return address for consumer response correspondence, as suggested by Lorch (pg 35, lines 3-14).

19. As per claim 49, Lorch teaches the medium of claim 41 as described above. Lorch further teaches instructions which cause the computer to: place the pseudo name on the mail object to identify a recipient of the mail object (pg 11, lines 12-14); and also teaches that a sender name and physical address is placed on the mail object to identify a sender of the mail object (Fig. 1); however does not explicitly teach that the pseudo name is placed on the mail object to identify a sender of the mail object rather than just the recipient. It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the above feature for the reasons set forth above with respect to claim 45.

20. Claims 46 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorch, et al. in view of Law, U.S. Pat. No. 7,072,845 (Reference A of the attached PTO-892).

21. As per claim 46, Lorch teaches the system of claim 45 as described above. Lorch does not explicitly teach the sender is billed for the one or more mail services associated with the pseudo name according to the method of payment for the mail object included in the franking profile; which is taught by Law (col 3, lines 46-56; col 5, lines 1-8). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Law because this is merely a combination of old elements. In the combination each element would have performed the same function as it did separately, and one skilled in the art would have recognized that the results of the combination could be implemented through routine engineering producing predictable results.

22. As per claim 50, Lorch teaches the medium of claim 49 as described above. Lorch does not explicitly teach instructions which cause the computer to bill the sender for the one or more mail services associated with the pseudo name according to the method of payment for the mail object included in the franking profile; which is taught by Law (col 3, lines 46-56; col 5, lines 1-8). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Law because this is merely a combination of old elements. In the combination each element would have performed the same function as it did separately, and one skilled in the art would have recognized that the results of the combination could be implemented through routine engineering producing predictable results.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL P. VETTER whose telephone number is (571)270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JOHN W HAYES/
Supervisory Patent Examiner, Art Unit 3628